IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, A. D. 1953

NO. 519

JEOFFROY MFG. INC., ROY JEOFFROY AND RAY L. JEOFFROY, Petitioners,

versus

WILLIAM T. GRAHAM AND GRAHAM-HOEME PLOW CO., INC., Respondents.

PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI

TO THE UNITED STATES SUPREME COURT AND THE JUSTICES THEREOF:

Petitioners, Jeoffroy Mfg. Inc., et al, respectfully pray for a rehearing and reversal of the order hereinbefore entered on the 8th day of March, 1954, denying their petition for writ of certiorari to the United States Court of Appeals for the Fifth Circuit, on the following grounds:

I. *Substantial Matter Not Previously Presented.*

A. Improbability of Conflicting Decisions.

Petitioners and Respondents reside and have their places of business in Amarillo, Texas. They have been since about 1937 and are now the principal manufacturers of chisel plows in the United States. The chisel plow manufacturing business is thus concentrated not only in the Fifth Circuit but also within the Northern District of Texas, Amarillo Division. There is not, therefore, any real likelihood that there will be litigation of Graham Patent No. 2,493,811 in another circuit and consequently no likelihood of conflicting decisions with respect to said patent. Under such circumstances certiorari should be granted. *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 50, 83 L. Ed. 34, 59 S. Ct. 8 (1938); *Muncie Gear Works v. Outboard, M. & Mfg. Co.*, 315 U.S. 759, 765, 86 L. Ed. 1171, 62 S. Ct. 869 (1941).

In the *Schriber* case, at p. 50, Mr. Justice Stone for the court said:

> "We . . . granted certiorari . . . on a petition for rehearing showing that, notwithstanding the questionable validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit."

And in the *Muncie* case, at p. 765, Mr. Justice Jackson said:

> "While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely."

The nature of the substantive questions involved is set out in Petitioners' original petition and brief. Those questions, coupled with the improbability of conflicting decision, in the light of the above cases, present valid ground for certiorari.

B. Concurrent Finding Rule Inapplicable.

The Trial Court found invention based upon "structural novelty in the fulcrum assembly and even greater merit in the reputed suitability of such structure for digging a scalloped pattern through the plowed earth," (R. 16), which considerations the court held "save this patent from the condemnation of" the *A & P* case. (R. 17) Novelty was detailed in the court's letter to counsel. (R. 1359, footnote 6, and Appendix "A", p. 91 of Petitioners' original brief herein.) The Court of Appeals for the Fifth Circuit approved generally but not specifically the Trial Court's findings of novelty, saying:

> "While these findings are ably and clearly expressed, it is not necessary that we find the Graham Patent to possess novelty in each and every respect mentioned." (R. 1360, last paragraph of footnote 6.)

The Court of Appeals further said:

> "Independently of those findings (of novelty), we think the evidence fairly establishes that the patentee, Graham, was the first to perfect the idea of resilient and frictional engagement of the shank of a ground working tool between a fixed part and a movable part, or between the bracket on the H-beam and the fulcrum plate pivotally mounted on the bracket. His production of an efficient mounting for a ground working tool shank that would permit it to rock or vibrate, and yet obviate the

necessity of it being hinged directly on a fixed member, as in the Valley City device and the prior art, was novel both in method of operation and result accomplished, and, we think, entitled him to a valid patent on the combination claimed. The Graham patent may not here be invalidated under the tests for invention laid down in the *A & P Tea Co.* case, *supra,* since that case involved only uniting old elements 'with no change in their respective functions', whereas the patent here involved combines both old and new elements to produce a new result." (R. 1363)

The findings upon which the two courts below sustain invention and validity are not concurrent findings. They are separate findings with little relation to each other. Further, neither court has made specific findings of validity with respect to the individual claims; each has rather made a blanket finding of validity as to the entire patent. In this connection we point out that one of the features settled upon by each of the courts below as sustaining validity is not found in any of the claims of the patent.

The Trial Court relied in part on the suitability of the structure for digging a scalloped pattern through the earth. That result is described (R. 1028, col. 4, l. 44-53 and R. 1029, col. 5, l. 69-col. 6, l. 5) but not claimed. Pumping action, which produces the scalloped pattern, is both described and claimed, but Respondents' expert testified that while such action is a result of the structure, it "is not an essential part of the patent." (R. 994-995)

The Court of Appeals settled on resilient and frictional engagement of the shank between a fixed part and a movable part, obviating the necessity of direct hinging of the shank on

a fixed member. The patent speaks of frictional engagement or resistance one time (R. 1029, col. 5, l. 57); it does not speak of obviating direct hinging at all. The claims are silent as to both of those features.

Two things are clear: (1) Each court below has made separate findings upon which it bases a conclusion of invention. (2) None of the claims as drawn define the alleged invention in terms of *scalloped pattern, frictional engagement* or *nondirect hinging,* thus the findings of each court upon which it bases invention relate to some matters not found in the claims at all. For those reasons the concurrent finding rule is inapplicable and certiorari should be granted. *Altoona Pub. Theatres v. Am. Tri-Ergon Corp.*, 294 U.S. 477, 480, 487, 79 L. Ed. 1005, 55 S. Ct. 455 (1934).

II. *Intervening Circumstances of Substantial Effect.*

On February 10, 1954, after the original petition for certiorari was filed herein, the District Court for the Northern District of Texas, Amarillo Division, entered judgment in Civil No. 1469, *Jeoffroy Mfg., Inc. v. William T. Graham,* which is in conflict with the decision of the Fifth Circuit in the instant case. (A copy of the judgment in No. 1469 is attached to this petition as Appendix "A". There is no published opinion.)

After the decision of the Trial Court on September 30, 1951 in the instant case (R. 14), Petitioner, Jeoffroy Mfg., Inc., redesigned its spring trip by placing the shank underneath the hinge member and bolting the two parts solidly together, thus directly and fixedly attaching the shank to the hinge member, eliminating all clamping action of the hinge member upon the shank, eliminating any frictional engage-

ment of the shank with the hinge member, and eliminating movable engagement of the shank with the hinge member.

The Trial Court held that the new Jeoffroy structure does not infringe claims 1, 2, 3, 4, 7 and 8 but does infringe claims 5 and 6 of Patent No. 2,493,811. That holding with respect to claims 5 and 6 is squarely in the teeth of the decision of the Fifth Circuit in the instant case wherein, as we have pointed out in I. B. above, the court emphasized as invention the resilient and frictional engagement of the shank between a movable part and a fixed part thereby obviating the necessity of direct hinging of the shank.

This recent decision of the Amarillo Division of the District Court for the Northern District of Texas in Civil No. 1469 emphasizes the uncertainty that results from the opinion of the Fifth Circuit in the case at bar and the importance of review by the Supreme Court.

Respectfully Submitted,

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S. TOM MORRIS
630 Amarillo Building
Amarillo, Texas
ATTORNEYS FOR PETITIONERS

By W. W. GIBSON

CERTIFICATE

I hereby certify that the above petition for rehearing is presented in good faith and not for delay, that it is limited to the grounds above specified as provided by Rule 33 (2) of the Rules of the Supreme Court, and that two copies of this petition have been sent by United States mail, postage prepaid, to Clayton Heare, Amarillo Building, Amarillo, Texas, and Claude A. Fishburn and Orville O. Gold, 1217 Commerce Trust Building, Kansas City, Missouri, attorneys for Respondents.

Dated March 19th, 1954.

W. W. GIBSON

Attorney for Petitioners

APPENDIX "A"

IN THE DISTRICT COURT OF THE UNITED STATES FOR THE NORTHERN DISTRICT OF TEXAS, AMARILLO DIVISION

JEOFFROY MFG., INC.,
Plaintiff,
VS.
WILLIAM T. GRAHAM,
Defendant.
CIVIL ACTION NO. 1469

JUDGMENT

This cause having been tried upon proceedings in open Court without jury upon the original complaint for Declaratory Judgment and the defendant's second amended answer and counterclaim or cross action and plaintiff's reply to said counterclaim, and the Court having heard and considered the evidence, the briefs and argument of counsel, and the Court being fully advised in the premises, it is

ORDERED, ADJUDGED and DECREED, as follows:

1. The Graham patent No. 2,493,811 is good and valid in law; William T. Graham was the first, true and original inventor of the invention, improvement and combination disclosed in said patent; and defendant, William T. Graham, is the lawful owner of the entire right, title and interest in and to said invention.

2. Plaintiff, Jeoffroy Mfg., Inc., has infringed claims 5 and 6 of patent No. 2,493,811.

3. Plaintiff, Jeoffroy Mfg., Inc., its officers, confederates, associates, servants, attorneys, agents, clerks and workmen, and every person acting for or on behalf of said plaintiff, are hereby perpetually enjoined and restrained from directly or indirectly making or causing to be made, selling or causing to be sold, using or causing to be used, any device embodying the inventions defined by claims 5 and 6 of the Graham patent No. 2,493,811.

4. Plaintiff has not infringed claims 1, 2, 3, 4, 7 and 8 of Graham patent No. 2,493,811.

5. The Graham patent No. 2,627,798 is invalid and the defendant's counterclaim or cross action is dismissed as to said patent.

6. The defendant, W. T. Graham, shall recover from the plaintiff, Jeoffroy Mfg., Inc., for infringement of patent No. 2,493,811, general damages, as well as all further recovery authorized by law and that may be hereafter awarded in the discretion of the Court, and the said plaintiff, its officers, agents, clerks and employees shall submit to such oral examination as may be directed, and shall preserve and produce, as ordered, all of said plaintiff's books, vouchers, accounts and other documents relating in anywise to said infringement.

7. The Court retains and reserves jurisdiction for the purpose of ascertaining and fixing the amount of general damages, as well as all further recovery authorized by law and that may be awarded in the discretion of the Court, in favor of the Defendant and against the said plaintiff, and for the purpose of fixing and taxing the costs and the amount thereof to be paid by the respective parties.

Signed this 10th day of February, 1954.

/s/ Jos. B. Dooley
United States District Judge

APPROVED AS TO FORM:

/s/ S. Tom Morris
Of Counsel for Plaintiff

/s/ Clayton Heare
Of Counsel for Defendant

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In the Supreme Court of the United States

October Term, A.D., 1953.

No. 519.

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vs.

WILLIAM T. GRAHAM AND GRAHAM-HORMEE PLOW CO., INC.,
Respondents.

RESPONDENTS' RESPONSE TO PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI.

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RESPONDENTS' RESPONSE TO PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI.

May It Please the Court:

Respondents, in this response to petition for rehearing after denial of certiorari filed by the petitioners, will refer to the points raised by petitioners in their petition in the order named therein.

I.

"Substantial matter not previously presented."

A. "Improbability of conflicting decisions."

Petitioners in their brief (p. 2) state that "the chisel plow manufacturing business is thus concentrated not only in the Fifth Circuit but also within the Northern District of Texas, Amarillo Division."

This is an erroneous statement. This Honorable Court no doubt knows that the manufacture of farm equipment is not concentrated in the Fifth Circuit. There are many large plow manufacturers located outside of the Fifth Circuit, many of whom manufacture chisel type plows at the present time.

Respondents' attorney has, since the receipt of the petitioners' petition, inspected a copy of the Implement and Tractor Index to Product Information of December 19, 1953. This publication lists under the heading of "Plows" in excess of one hundred companies as manufacturers of or dealers in plows, including the following:

J. I. Case Company, Racine, Wisconsin (Seventh Circuit).
Athens Plow Co., Athens, Tennessee (Sixth Circuit).
Oliver Corporation, South Bend, Indiana (Seventh Circuit).
Love Tractor Co., Eau Claire, Michigan (Sixth Circuit).
Taylor Implement Company, Athens, Tennessee (Sixth Circuit).

Respondents state that the following companies, large manufacturers of farm equipment of various types, also make chisel plows at the present time:

Allis-Chalmers Manufacturing Co., Milwaukee, Wisconsin (Seventh Circuit), with factories at

Athens, Tenn. (Sixth Circuit); La Porte, Ind. (Seventh Circuit); Oxnard, Calif. (Ninth Circuit), and sales office at Kansas City, Missouri (Eighth Circuit).

Massey-Harris Company, Racine, Wisconsin (Seventh Circuit).

John Deere Plow Co., Moline, Illinois (Seventh Circuit); factories in Syracuse, N. Y. (Second Circuit); Los Angeles, California (Ninth Circuit); Dubuque, Iowa (Eighth Circuit).

Cockshutt Farm Equipment, Ltd., Bellevue, Ohio (Sixth Circuit).

Krause Manufacturing Company, Hutchinson, Kansas (Tenth Circuit).

The Tractor and Implement Index above referred to shows a listing under the heading, "Plows—Chisel and Sub-Soil," page 357, twenty-three names listed as manufacturers of or dealers in such plows, some of whom are the following:

Atlas Scrapper & Engineering Company, Bell, California (Ninth Circuit).

Baraboo Manufacturing, Inc., Baraboo, Wisconsin (Seventh Circuit).

Cheney Weeder Co., Cheney, Washington (Ninth Circuit).

Glencoe Manufacturing Co., Glencoe, Minnesota (Eighth Circuit).

International Harvester Company, Chicago, Illinois (Seventh Circuit).

Kirkendahl Plow Co., Newkirk, Oklahoma (Tenth Circuit).

Vassar Manufacturing Co., Perkins, Oklahoma (Tenth Circuit).

Western States Equipment Co., Golden, Colorado (Tenth Circuit).

It is very likely that many of the plow companies located in other circuits as shown above and particularly in the

Sixth, Seventh, Eighth, Ninth and Tenth Circuits, who are not now manufacturing and selling chisel type plows, may enter into that field, and particularly is it true that a large majority of the plow manufacturing industry is located in the Sixth and Seventh Circuits.

From the above it is clear that the plow industry is not concentrated in the Fifth Circuit as alleged by petitioners, as was the automobile industry in the *Schriber-Schroth Co.* v. *Cleveland Trust Co.* case, 305 U. S. 47, 50, 83 L. Ed. 34, 59 S. Ct. 8, nor does the patent dominate a substantial portion of an industry so concentrated in the Fifth Circuit that litigation in other circuits resulting in a conflict of decisions is unlikely as was the situation in the case of *Muncie Gear Works* v. *Outboard M. & Mfg. Co.,* 315 U. S. 759, 765, 86 L. Ed. 1171, 62 S. Ct. 869, both of which cases are relied on by petitioners in support of this point in their petition for rehearing.

Respondents submit the petitioners' point of improbability of conflicting decisions is not supported by the facts and since the chisel plow manufacturing industry is not concentrated in the Fifth Circuit, the Schriber and Muncie cases are not in point.

B. "Concurrent finding rule inapplicable."

Under this heading the petitioners attempt to show that this point was not heretofore considered.

Reference to the trial court's and the Court of Appeals for the Fifth Circuit's opinion was made in petitioners' brief in support of its petition for certiorari under Point D, "Findings of Validity" (pp. 11 and 12), and again at pp. 17, 18 and 19), wherein it is stated that the trial court held there was novelty in the fulcrum assembly as well as in the suitability of the structure for digging a scalloped pattern through the plowed earth. The Court of Appeals

adopted these findings of the trial court, but set out its additional reasons for holding of novelty of the device of the patent in suit and distinguished it from the A & P case. Now the petitioners attempt to say that the two lower courts are in conflict in their decisions. Such is not a true statement of the facts. Nowhere in the opinion of the Court of Appeals for the Fifth Circuit did it disagree with the findings of the trial court.

Petitioners, in their petition for rehearing (p. 4), state that neither of the lower courts has made specific findings of validity with respect to the individual claims, and that features settled on by each of the courts below as sustaining validity are not found in any of the claims of the patent.

Apparently the petitioners are referring to the mention of a scalloped pattern by the trial court. The claims of the patent are not directed to a result and, therefore, do not mention a "scalloped pattern." They properly define a structure which results in a scalloped pattern in the earth, to which the trial court was referring. The trial court clearly found novelty in the fulcrum assembly structure which is specified in each of the claims of the patent in suit and this is a point of novelty of such claims.

The Court of Appeals did not say the trial court was wrong in holding novelty in the fulcrum assembly. Apparently petitioners criticize the Court of Appeals because it made reference to *resilient* and *frictional* engagement of the end of the shank of the plow by the fulcrum member and bracket part of the clamp (R. 1363). The claims, and particularly claims 5 and 6 (R. 1030), refer to the shank being held between the fulcrum member and bracket in their "resiliently held together asssociation" so that when the shank is rocked or moved the end portion of the shank between the parts will cause the movable part of the clamp to move away from the fixed part, the end

portion of the shank being contactingly held between the two parts. Some of the other claims mention the clamping of the end of the shank between the movable part and the fixed part of the clamp. Respondents respectfully submit, therefore, that there is ample support in the claims for the Court of Appeals' reference to resilient and frictional engagement of the end of the shank between a fixed part and a movable part.

It is further clear that there is no conflict in the decisions of the two lower courts by a reading of the opinion of the Court of Appeals for the Fifth Circuit (R. 1363), where it was stated:

> "• • • Without detailing its structural features at great length, it seems to us that, from the evidence and the various exhibits, the District Court was justified in its findings of novelty in the Graham fulcrum assembly and its unique method of operation. • • •"

Then the Court of Appeals for the Fifth Circuit pointed out "independently of those findings" that there was additional novelty in the Graham invention (R. 1363-4).

The present case distinguishes from the *Altoona* case (294 U. S. 477, 480, 487, 79 L. Ed. 1005, 55 S. Ct. 455) relied upon by petitioners (p. 4), because there the only point of novelty in the patent in suit was not found in any of the claims. In the present case both courts found novelty in the Graham fulcrum assembly.

There clearly were concurrent findings by the trial court and the Court of Appeals for the Fifth Circuit and this point of petitioners' petition for rehearing has no basis in the record.

II.

"Intervening circumstances of substantial effect."

Under this heading, petition page 5, petitioners have set forth the decision of the District Court for the Northern District of Texas, Amarillo Division, in another case between substantially the same parties, Civil No. 1469, recently decided by said court wherein petitioners alleged that such ruling is in conflict with the decision of the Fifth Circuit in the present proceeding and again proceeds to set forth an alleged state of facts in that case which are not in the present case.

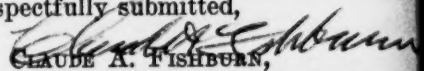
Such a set of facts do not constitute intervening circumstances of substantial effect referred to in Rule 33 (par. 2) of the rules of this Court. This Court cannot decide whether or not the trial court was wrong in a later case where the facts of said case are not before this Court. This Honorable Court cannot attempt to decide facts not before it and the only facts before it are those in the present record. What the same trial court holds in a later case has no bearing on the Court of Appeals' opinion or this Court's opinion in the present case. If the trial court in the second case made an error, then the time for this Court to correct that error is when such case properly comes before it on writ of certiorari.

In conclusion, it is respectfully submitted that petitioners have not brought forth in their petition for rehearing intervening circumstances of substantial or controlling effect or other substantial grounds available to petitioners, although not previously presented, as provided in the rules of this Court.

Respondents again submit that petitioners are merely seeking to have the Supreme Court provide a third review of the evidence to determine whether the findings of fact are properly substantiated by the evidence.

The petition for rehearing should be denied.

Respectfully submitted,



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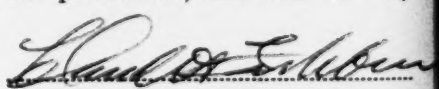
Certificate of Service.

Two copies of the foregoing response to petitioners' petition for rehearing after denial of certiorari have been sent by United States mail, postage prepaid, to W. W. Gibson and S. Tom Morris, 630 Amarillo Building, Amarillo, Texas, attorneys for petitioners, this 26 day of March, 1954.



Attorney for Respondents.